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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,692	07/24/2003	Gene J. Wolfe	201176-6	9938

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EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,692

Applicant(s)

WOLFE ET AL.

Examiner

DIANE D. MIZRAHI

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

III. DETAILED ACTION

Claims 1-32 are presented for examination.

Applicant's arguments submitted on June 23, 2006 with respect to claims 1-32 have been reconsidered but are not deemed persuasive for the reasons set forth below.

Examiner's USC 101 rejection of claims 1-32 is maintained. Examiner asserts that 1-62 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete." (See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility
<[http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101 20051026.pdf](http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101%20051026.pdf)>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Examiner withdraws the Claim rejection under 35 USC 112 for claims 4, 15 and 25.

In light of the newly submitted claimed limitation, "the preservation objects capable of being analog data corresponding to a visible image on the preservation media" and described by Applicant "such as compact disc, DVD, or other media"

(Applicant's amendment, page 9) is clearly taught by art-based rejection in view of Gustman (see below office action dated January 16, 2006 incorporated within):

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

States and was published under Article 21(2) of such treaty in the English language.

Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Samuel Gustman (U.S. Patent No. 6,353,831 B1 and Gustman hereinafter).

Regarding Claim 1, Gustman teaches content preservation system comprising: at least one content interface adapted to receive content (col 7, lines 62-67) (col 49-67 to col 9, lines 1-6); a document vault configured to associate metadata with received content; a storage management system that manages preservation specifics and queues one or more preservation objects for preservation (col 9, lines 44-67 to col 10, lines 1-3); and a preservation store adapted to preserve one or more preservation objects on preservation media (col 8, lines 49-67).

In regards to the newly submitted limitation, "the preservation objects capable of being analog data corresponding to a visible image on the preservation media", is clearly taught by Gustman (Figure 6) (col 8, lines 16-48) (col 4, lines 5-13).

Regarding Claim 2, Gustman teaches ...shelf management module adapted to perform classification, indexing, management and retrieval functionality (col 9, line 44-54).

Regarding Claim 3, Gustman teaches a data store, the data store adapted to store metadata that serves as a representation of the preservation object datum and indexers (col 14, lines 22-47) (col 9, lines 55-67 to col 10, lines 1-3).

Regarding 4, Gustman teaches the data store has the ability to preserve a representation of itself with a superset of all or a portion of preservation requirements of managed jobs (col 4, lines 56-67 to col 5, lines 1-3) (Figure 7B).

Regarding Claim 5, Gustman teaches preservation store controller and preservation store that preserve the one or more preservation objects on preservation media (col 14, lines 23-48).

Regarding Claim 6, Gustman teaches one or more of preservation, retrieval, metadata and queue management (col 9, lines 55-67 to col 10, lines 1-3).

Regarding Claim 7, Gustman teaches ... cooperates with storage management system to facilitate retrieval of preserved content (col 9, lines 55-67 to col 10, lines 1-3).

Regarding Claim 8, Gustman teaches one or more of a preserved content identifier, a Boolean query, a text model and a query can be used to search for the preserved content (col 10, lines 33-41).

Regarding Claim 9, Gustman ... adapted to be associated with one or more of a print cartridge, a toner bottle and an ink reservoir (col 7, lines 15-26) (Figure 1, i.e. I/O).

Regarding Claim 10, Gustman teaches wherein the content is at least one of a document, digital content, a facsimile, multimedia, e-mail, video, web page and music (Figure 6) (col 8, lines 16-48).

Regarding Claim 11, Gustman teaches wherein the content preservation system stores the one or more preservation objects for at least one of an indefinite or predetermined amount of time (col 5, lines 37-46).

Regarding Claims 12-32, the limitations of these claims is similar in scope to the rejected claims above and are therefore rejected as set forth above.

Applicant's remarks are considered moot, and does not place the application in condition for allowance. Examiner asserts that "every limitation positively recited in a claims was given effect in order to determine what the subject matter that the claim defines" In re Wilder, 166 USPQ 545, 548 (CCPA 1970). Examiner believes that claims 1-32 are not allowable over the prior art of record cited in this Final Office Action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

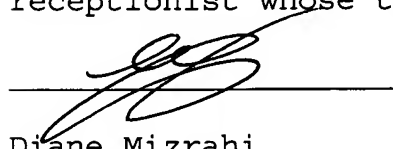
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'DM', is written over a horizontal line.

Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

August 20, 2006